

REMARKS

Claims 9-16 are all of the pending claims, with claims 1 and 9 being written in independent form. By this Amendment, claims 1-8 are cancelled without prejudice or disclaimer. Claims 9 and 10 are amended. No new matter is added.

Allowable Subject Matter

Claims 1-16 are indicated as being allowable if amended to overcome the rejections under 35 USC §101 of claims 1-8 and the rejections of claims 1-16 under 35 USC §112. As claims 1-8 are cancelled and claims 9-16 are amended to overcome the rejection under 35 USC §112, the application is in condition for allowance.

Rejection under 35 USC §112

Claims 9-16 are rejected under 35 USC §112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, it is alleged that there is no support in the specification for the “memory” recited in independent claim 9.

35 USC §112, first paragraph, recites [T]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicants respectfully submit that the definition of a “memory,” as used in the context of claim 9 is well-known. For example, according to the Microsoft® Computer Dictionary, Fifth Edition, a “memory” is “a device where information can be stored and retrieved.” As there is ample support in the specification for such a “memory,” the rejection on the grounds of 35 USC §112 is incorrect. For example, the specification describes a directory for storing object names of the automation objects and a central data store, such as a data base, that stores the data of automation solutions. Thus, even a cursory reading of the specification reveals that the specification includes support for a memory. Moreover, given the well-known meaning of the term, it is apparent that one of skill in the art would readily recognize the meaning of a memory.

Applicants also object to the rejection of the term at this late stage of prosecution as the term at issue has been included in claim 9 since January 2, 2004.

Although Applicants traverse the rejection of the claims under 35 USC §112, first paragraph, the claims are amended in an effort to aid in the Examiner's understanding of the claimed subject matter and expedite prosecution of the application. As the claims are amended to overcome the rejection, withdrawal of the rejection is respectfully requested.

Claims 1, 2, 9 and 10 are rejected under 35 USC §112, second paragraph, due to the recitation of "respective." As the word "respective" is deleted from the claims, withdrawal of the rejection is respectfully requested.

Objection to the Specification

The specification is objected to for allegedly failing to define the word "memory" in the specification. As there is no basis in rule or law cited for objecting to the specification, the objection is improper. Moreover, as the word "memory" is no longer recited in the claims, the objection is moot.

Rejection under 35 USC §101

Claims 1-8 are rejected under 35 USC §101 for allegedly not being drawn to statutory subject matter. Specifically, it is alleged that the system of claims 1-8 fails to include "physical articles or objects to constitute a machine or a manufacture with the meaning 35 USC §101.

Applicants respectfully remind the Examiner that 35 USC §101 recites, [W]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title. Thus, limiting 35 USC §101 to only machines, manufactures and processes is well outside of the scope of authority of the Examiner.

Applicants respectfully submit that the subject matter of claims 1-8 includes subject matter that is at least a composition of matter. For example, a plurality of automation objects exist which may be evidenced by their manipulation and storage. The automation objects take up space in that they may be stored and therefore must be a composition of matter. The claimed directory is at least a machine, manufacture and a composition of matter in that it exists and takes

up space. The directory is also useful in that it stores automation objects. Similarly, the directory entries must certainly be at least a composition of matter and be useful in that they contain information related to the automation objects that is identifiable and storable.

Although claims 1-8 are improperly rejected under 35 USC §101, the claims are cancelled in an effort to expedite prosecution of the present application. As such, withdrawal of the rejection is respectfully requested.

CONCLUSION

Reconsideration and allowance of the pending claims is earnestly solicited.

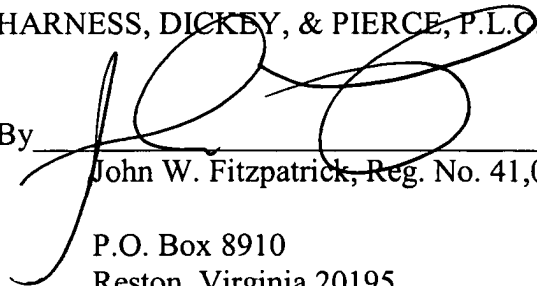
Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John Fitzpatrick at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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